

REMARKS

In the Office Action¹ mailed August 9, 2006, the Examiner objected to the Amendment filed May 30, 2006 as allegedly introducing new matter; rejected claims 1, 3, 4, 6, 8, 9, 11, 12, and 14 under 35 U.S.C. § 112, first and second paragraphs, rejected claims 1, 3, 4, 6, 8, 9, 11, 12, and 14 under 35 U.S.C. § 101; rejected claims 1, 3, 6, 8, 9, 12, and 14 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,167,383 to Henson ("*Henson*"); rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of U.S. Patent No. 5,974,395 to Bellini et al. ("*Bellini*"); and rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of U.S. Patent No. 6,188,989 to Kennedy ("*Kennedy*").

By this Amendment, Applicant amends claim 1.

Applicants respectfully traverse the objection to the Amendment filed May 30, 2006 under 35 U.S.C. § 132(a). According to the Examiner, the feature "candidate determining means for..." is not supported by the original disclosure (Office Action at p. 2). Applicants have amended claim 1 to recite, among other things, "proposed-order determining means for determining a proposed order including a list of one or more related commodities determined to be connectable to the commodity based on related commodity information associated with the commodity." Applicants respectfully submit that support for this feature can be found, for example, on pages 5, 57, 76-77, and 79 of the original disclosure and request the objection be withdrawn.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Applicants respectfully traverse the rejection of claims 1, 3, 4, 6, 8, 9, 11, 12, and 14 under 35 U.S.C. § 112, first and second paragraphs, as failing to comply with the written description requirement and as being indefinite. The Examiner stated that the feature “candidate determining means” was not supported by the specification. The Examiner also stated that the “words ‘candidate’ and ‘order candidate’ in claim 1 are relative words, which renders the claim indefinite” (Office Action at p. 3). Applicants have amended claim 1, deleting the term “candidate.” Amended claim 1 now recites, among other things, “proposed-order determining means.” Applicants submit that support for this feature can be found, for example, on pages 5, 57, 76-77, and 79 of the original disclosure and respectfully request the rejections under 35 U.S.C. § 112, first and second paragraphs, be withdrawn.

Regarding the rejection of claims 1, 3, 4, 6, 8, 9, 11, 12, and 14, under 35 U.S.C. § 101, the Examiner states, “the apparatus of claim 1 comprises a series of programs” and further states that “a program is not a physical structure, and therefore the apparatus of claim 1 has no physical structure” (Office Action at p. 4). Applicants respectfully traverse this rejection.

In order to satisfy the requirements of 35 U.S.C. § 101, the claimed invention as a whole must at least accomplish a practical application. That is, it must produce a useful, concrete, and tangible result. *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1373, 47 USPQ2d 1596, 1601-1602. Claim 1 recites a useful “commodity selling apparatus.” The claimed apparatus is used for accepting an order of a commodity responsive to a request by a costumer to purchase

the commodity over a network and for directly shipping the ordered commodity to said customer.

As stated in the M.P.E.P.: “[i]f a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product.” M.P.E.P. § 2106, 8th Ed. (Rev. 4), October, 2005. Here, the claimed “commodity selling apparatus,” in combination with the claimed “order information acquisition means,” “proposed-order determining means,” “related commodity information transmission means,” and “commodity shipping command means,” defines a hardware and software combination that produces a useful, concrete, and tangible result. Accordingly, Applicants respectfully submit that claim 1 and dependent claims 3, 4, 6, 8, 8, 11, 12, and 14 define a statutory product within the definition of 35 U.S.C. § 101.

Applicants respectfully traverse the rejection of claims 1, 3, 6, 8, 9, 12, and 14 under 35 U.S.C. § 102(e) as being anticipated by *Henson*. *Henson* does not disclose or suggest each and every element of those claims. For example, claim 1 recites a commodity selling apparatus comprising, among other things:

proposed-order determining means for determining a proposed order including a list of one or more related commodities determined to be connectable to the commodity based on related commodity information associated with the commodity.

Henson discloses a system for providing customer configured machines at an Internet site (Fig. 3A). *Henson* discloses a configurator for configuring a computer system with options selected according to a prescribed user input (Abstract). *Henson* discloses presenting the user with the options and a respective pricing for each option on a configurator web page in accordance with the identification of the user belonging to

a prescribed customer set. The configurator in *Henson* includes, at col. 5, lines 1-2, a validation (or compatibility) warning module, which provides the customer with a validation message when the options selected for a particular system are not correct (see col. 7, lines 57-61).

Henson also discloses, at col. 9, lines 55-57, providing recommendations based upon contents of the “shopping cart,” including something that could be recommended as an “upgrade” or a “cross-sell,” but does not disclose related commodities determined as connectable to a commodity. Because *Henson* merely discloses providing recommendations for upgrading or “cross-selling” articles already in a shopping cart, *Henson* does not disclose proposed-order determining means for determining a proposed order including a list of one or more related commodities determined to be connectable to the commodity based on related commodity information associated with the commodity, as recited in claim 1.

For at least the foregoing reasons, Applicants submit that claim 1 is not anticipated by *Henson*. Claims 3, 6, 8, 9, 12, and 14 depend from independent claim 1 and are therefore allowable for at least the same reasons as independent claim 1. In addition, the dependent claims may recite unique combinations that are neither taught nor suggested by prior art.

Applicants respectfully traverse the rejection of claim 4 as being unpatentable over *Henson* in view of *Bellini*, because a *prima facie* case of obviousness has not been established with respect to claim 4. Even if combinable as suggested by the Examiner, *Henson* and *Bellini* fail to disclose or suggest the claimed subject matter.

For example, *Henson* and *Bellini*, either taken alone or in any reasonable combination, do not teach or suggest proposed-order determining means for determining a proposed order including a list of one or more related commodities determined to be connectable to the commodity based on related commodity information associated with the commodity, as recited in independent claim 1.

Henson fails to disclose an apparatus having the claimed proposed-order determining means. *Bellini* also fails to disclose the claimed apparatus. According to the Examiner, *Bellini* discloses a commodity selling apparatus (Office Action at p. 10). However, *Bellini* does not disclose proposed-order determining means for determining a proposed order including a list of one or more related commodities determined to be connectable to the commodity based on related commodity information associated with the commodity as recited in claim 1. Therefore, the subject matter of claim 4 would not have been obvious to one of ordinary skill in the art in view of *Henson* and *Bellini*.

Applicants respectfully traverse the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of *Kennedy*. Even if combinable as suggested by the Examiner, *Henson* and *Kennedy* fail to disclose or suggest the claimed subject matter.

For example, *Henson* and *Kennedy*, either taken alone or in combination, do not teach or suggest proposed-order determining means for determining a proposed order including a list of one or more related commodities determined to be connectable to the commodity based on related commodity information associated with the commodity. *Henson* fails to disclose a commodity selling apparatus as recited in claim 1. *Kennedy* does not cure the deficiencies of *Henson*.

According to the Examiner, *Kennedy* discloses, at col. 2, lines 37-45, col. 3, lines 35-41, and col. 15, lines 38-46, "a commodity selling apparatus" (Office Action at p. 12). However, *Kennedy* does not disclose or suggest an apparatus having proposed-order determining means for determining a proposed order including a list of one or more related commodities determined to be connectable to the commodity based on related commodity information associated with the commodity. Therefore, the subject matter of claim 11 would not have been obvious to one of ordinary skill in the art in view of *Henson* and *Kennedy*.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: /Michael R. Kelly/
Michael R. Kelly
Reg. No. 33,921